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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,825	03/11/2004	James Mason Boswell	MS1-1912US	8389
22801	7590	02/11/2008		
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			EXAMINER GOODCHILD, WILLIAM J	
			ART UNIT 2145	PAPER NUMBER
			MAIL DATE 02/11/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/799,825

**Applicant(s)**

BOSWELL ET AL.

**Examiner**

WILLIAM J. GOODCHILD

**Art Unit**

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-850)  
Paper No(s)/Mail Date 03/11/2004, 10/04/2004  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim(s) 1-7 comprise computer readable media, which may comprise computer storage media and communications media [Specification, page 27, lines 11-15]. In accordance with Applicant's specification (page 28, lines 1-10, " 'Communications media' typically embodies computer readable instructions, data structures, program modules, or other data in a modulated data signal, such as carrier wave or other transport mechanism") the transmission media may be an electromagnetic signal. This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter

In addition, claim(s) 1-7 can be considered to be software, consisting of determining if a threshold number of messages has been met and deleting or adding messages to a message queue. In order for a claim to be statutory, it must fall within a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 8-10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al., (US Publication No. 2003/0228909), (hereinafter Tanaka), and further in view of Beerman, Jr. et al., (US Patent No. 6,084,952), (hereinafter Beerman).

In reference to claims 1, 8 and 14, Tanaka discloses a memory to store a message queue [paragraph 111]; identify whether a message queue for a targeted recipient of a new message has more than a threshold number of messages [paragraphs 87 and 89-90]; if the queue does not have more than the threshold number of messages then add the new message to the message queue [paragraphs 87 and 89-90]; and if the queue does have more than the threshold number of messages, then: determine, one of the messages in the message queue to delete from the message queue [paragraphs 37, 91, 93 and 98], delete the one message from the message queue [paragraphs 75 and 91], and add the new message to the message queue [paragraph 89]. Tanaka does not specifically disclose based on a sender of the new message. However, Beerman, discloses filtering performed based on the name of the sender [Beerman, column 14, lines 11-12]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the sender of the message in order to enhance determining which message to delete.

Regarding claim 9, Tanaka further discloses performing the identifying and checking only if greater than a threshold quantity of messages are in the plurality of messages [Tanaka, paragraphs 89-90]; and keeping the plurality of messages in the message queue without deleting any of the plurality of messages from the message queue if greater than the threshold quantity of messages are not in the plurality of messages [Tanaka, paragraphs 89-90].

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Regarding claim 10, Tanaka-Beerman further discloses the checking whether one or more criteria regarding the message queue are satisfied comprises checking whether the plurality of messages includes a threshold quantity of messages having a sender identity that is the same as the identity of the sender of the message [Beerman, column 14, lines 11-12].

Regarding claim 12, Tanaka further discloses the sender comprising a user of a game console [Tanaka, Abstract].

Regarding claim 13, Tanaka further discloses the sender comprising a game title [Tanaka, Abstract].

Regarding claim 15, Tanaka further discloses the message queue is associated with a targeted recipient of the newly received message [Tanaka, paragraphs 36 and 53].

4. Claims 2-7, 11 and 16-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka-Beerman as applied to claims 1, 8 and 14 above, and further in view of Torvinen, (US Publication No. 2004/0242202).

Regarding claim 2, Tanaka-Beerman further discloses identify a title that sent the new message [Beerman, column 14, lines 11-13]; if more then the second threshold number of messages from the title [Beerman, column 14, lines 11-13] are in the message

queue, then identify as the one message the oldest message in the message queue from the title [Tanaka, paragraph 90]. Tanaka-Beerman does not specifically disclose determine whether more than a second threshold number of messages from the title are in the message queue. However, Torvinen, discloses a second number of messages in a queue [Torvinen, paragraph 45 and figure 5]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a second number of message in a queue in order to allow for different messages from separate sources being available with differing priorities.

Regarding claim 3, Tanaka-Beerman-Torvinen further discloses if more than the second threshold number of messages [Torvinen, paragraph 45 and figure 5] from the title [Beerman, column 14, lines 11-13] and are not in the message queue, then identify as the one message the oldest message in the message queue regardless of the title that sent the new message [Tanaka, paragraph 90].

Regarding claims 4 and 18-19, Tanaka-Beerman-Torvinen further discloses identify a user that sent the new message [Beerman, column 14, lines 11-13]; determine whether more than a second threshold number of messages from the user are in the message queue [Torvinen, paragraph 45 and figure 5]; and if more than the second threshold number of messages from the user are in the message queue, then identify as the one message the oldest message in the message queue from the user [Tanaka, paragraph 90].

Regarding claim 5, Tanaka further discloses if more than the second threshold number of messages from the user are not in the message queue, then identify as the one message the oldest message in the message queue regardless of the user that sent the new message [Tanaka, paragraph 90].

Regarding claims 6, 16-17 and 20, Tanaka-Beerman-Torvinen further discloses identify a title that sent the new message [Beerman, column 14, lines 11-13]; determine whether more than a second threshold number of messages from the title are in the message queue [Torvinen, paragraph 45 and figure 5]; if more then the second threshold number of messages from the title [Beerman, column 14, lines 11-13] are in the message queue, then identify as the one message the oldest message in the message queue from the title [Tanaka, paragraph 90]; and if more than the second threshold number of messages from the title are not in the message queue, then: identify a user that sent the new message [Beerman, column 14, lines 11-13]; determine whether more than a third threshold [Torvinen, paragraph 11, line 6] number of messages from the user are in the message queue [Torvinen, paragraph 45 and figure 5]; if more than the third threshold number of messages from the user are in the message queue, then identify as the one message the oldest message in the message queue from the user [Tanaka, paragraph 90]; and if more than the third threshold number of messages from the user are not in the message queue, then identify as the one message the oldest message in the



message queue regardless of the user that sent the new message and regardless of the title that sent the new message [Tanaka, paragraph 90].

Regarding claim 7, Tanaka further discloses one or more messages may not be deleted from the message queue, and wherein to determine one of the messages in the message queue to delete from the message queue is to determine one of the messages that is not included in the one or more messages that may not be deleted from the message queue [Tanaka, paragraph 107].

Regarding claim 11, Tanaka-Beerman-Torvinen further discloses the one or more criteria include whether more than a first threshold number of messages sent by a title [Torvinen, paragraph 45 and figure 5] that sent the message are in the message queue [Beerman, column 14, lines 11-13], and whether more than a second threshold number of messages sent by a user [Beerman, column 14, lines 11-13] that sent the message are in the message queue [Torvinen, paragraph 45 and figure 5].

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM J. GOODCHILD whose telephone number is

(571)270-1589. The examiner can normally be reached on Monday - Friday / 9:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WJG  
01/28/2008

/Jason D Cardone/  
Supervisory Patent Examiner, Art Unit 2145